

**REMARKS**

***Formal Matters***

Claims 1-74, 76-84, 86 and 87 are pending in the instant application. Claims 68 and 78 have been amended as a matter of format to overcome the objection of the Examiner, as outlined on page 2 of an Office Action dated September 12, 2008. No new matter has been added.

In view of the following remarks, Applicants respectfully request reconsideration of Claims 1-74, 76-84, 86 and 87, the only claims under examination in the instant application.

***Claim Rejections- 35 U.S.C. § 102(a) and 102(e)***

In the Action, the Examiner rejected Claims 21, 22, 24, 45, 46, 48, 49, 66-69, and 76-79 of the instant application under 35 U.S.C. § 102(a) and 35 U.S.C. § 102(e) for alleged anticipation by Hennessey et al. (US Pub. No. 2004/0016702; hereafter Hennessey).

It is stated in the M.P.E.P § 715 that affidavits under 37 C.F.R. 1.131 for antedating a reference are appropriate for addressing rejection under 35 U.S.C. § 102(a) and 35 U.S.C. § 102(e). An affidavit antedating Hennessey is included with this Response.

As the affidavit establishes that various embodiments of methods of the instant application were invented prior to the effective date of Hennessey, the Applicants respectfully request that the rejections under 35 U.S.C. § 102(a) and 35 U.S.C. § 102(e) be withdrawn.

***Claim Rejections- 35 U.S.C. § 103(a)***

In the Action, numerous dependent claims were rejected under 35 U.S.C. § 103(a) as allegedly obvious over Hennessey as the primary reference. The Applicants aver that Hennessey is not available as a reference under U.S.C. § 103(a), as Hennessey and the instant application were owned by Apdera Corporation or subject to an obligation of assignment to Apdera Corporation at the time that the invention of embodiments of methods of the instant application were made. Accordingly, under U.S.C. § 103(c), Hennessey is not available as a reference for rejection under 35 U.S.C. § 103(a).

In the Action, claims 45, 80-82, and 87 were provisionally rejected under 35 U.S.C. § 103(a) as allegedly obvious over copending application Harrold et al. (US Pub. No. 2005/0196856; hereafter Harrold '856) as the primary reference (see section 10 of the Action; pp 11-12). The Applicants aver that Harrold '856 is not available as a reference under U.S.C. § 103(a), as Harrold '856 and the instant application were owned by Apdera Corporation or subject to an obligation of assignment to Apdera Corporation at the time that the invention of embodiments of methods of the instant application were made. Accordingly, under U.S.C. § 103(c), Harrold '856 is not available as a reference for rejection under 35 U.S.C. § 103(a).

In the Action, claims 45, 80-82, and 87 were provisionally rejected under 35 U.S.C. § 103(a) as allegedly obvious over copending application Harrold et al. (US Pub. No. 2006/0160122; hereafter Harrold '122) as the primary reference (see section 12 of the Action; pp 14-15). The Applicants aver that Harrold '122 is not available as a reference under U.S.C. § 103(a), as Harrold '122 and the instant application were owned by Applera Corporation or subject to an obligation of assignment to Applera Corporation at the time that the invention of embodiments of methods of the instant application were made. Accordingly, under U.S.C. § 103(c), Harrold '122 is not available as a reference for rejection under 35 U.S.C. § 103(a).

The Applicants respectfully attest that none of the primary references cited for the alleged obviousness rejection or the alleged provisional obviousness rejections are available as references under 35 U.S.C. § 103(c). Accordingly, no *prima facie* case of obviousness has been or could be made against the instant application using the cited references. As such, the Applicants request that the rejection and provisional rejections under 35 U.S.C. § 103(a) be withdrawn.

#### ***Provisional Nonstatutory Double Patenting Rejections***

In the Action, claims 45, 80-82, and 87 were provisionally rejected on the grounds of nonstatutory obviousness-type double patenting over claims 8, 21, and 29-36 of copending application Harrold '856 in view of Hennessey. Additionally, in the Action, claims 45, 80-82, and 87 were provisionally rejected on the grounds of nonstatutory obviousness-type double patenting over claims 12, 15, 21, 22 and 28-35 of copending application Harrold '122 in view of Hennessey.

In the M.P.E.P., section 804 B1, paragraph 2, it is stated:

"If "provisional" ODP rejections in two applications are the only rejections remaining in those applications, the examiner should withdraw the ODP rejection in the earlier filed application thereby permitting that application to issue without need of a terminal disclaimer."

Further, in the M.P.E.P., section 804 B1, paragraph 3, it is stated:

"Where there are three applications containing claims that conflict such that an ODP rejection is made in each application based upon the other two, it is not sufficient to file a terminal disclaimer in only one of the applications addressing the other two applications. Rather, an appropriate terminal disclaimer must be filed in at least two of the applications to link all three together. This is because a terminal disclaimer filed to obviate a double patenting rejection is effective only with respect to the application in which the terminal disclaimer is filed; it is not effective to link the other two applications to each other."

The Applicants respectfully submit that the present application is now in position for allowance, which action is requested. As stated in the M.P.E.P., section 804 B1, paragraph 3, the Applicants will submit terminal disclaimers for the two copending applications, Harrold '856 and Harrold '122.

*Appl. No. 10/780,963*

*Response dated January 14, 2009*

*Reply to Office Action of September 12, 2008*

If the Examiner finds that a telephone conference would expedite the prosecution of this case, the Examiner is invited to contact me at the telephone number listed below.

**Fee Authorization**

A two-month extension of time is hereby requested. The Commissioner is hereby authorized to charge **Deposit Account No. 01-2213 (order no. 5118)**. Any deficiency or overpayment should be charged or credited to this deposit account.

Respectfully submitted,

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Sally A. Swedberg, PhD

Reg. No. 53,659

Agent for Applicants

**CORRESPONDENCE ADDRESS**

Customer Number: 22896

Applied Biosystems Inc.

850 Lincoln Centre Drive

Foster City, California 94404

TEL: 650-554-2863

FAX: 650-638-6677